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Remarks

Status of Claims:

Claims 1-6, 8-10, and 16-24 are finally rejected. Claim 18 is amended. Claims 1-6, 8-10, and 16-24 remain pending.

112 Rejection:

Claim 18 is amended to depend from Claim 17. No new matter is added. Withdrawal of the rejection of Claim 18 under 35 USC 112 is requested.

102 Rejections:

Claims 1-3, 5-6, 8-10, 16, 21, 22, and 24

The above claims are rejected as anticipated by US 6,485, 436 (Truckai). It is respectfully urged that this rejection is improper for at least the reasons provided below.

First, the Examiner's rejection fails to explain how Truckai teaches each and every claim element and limitation. The only explanation the Examiner provides for the rejection of the above claims as being anticipated by Truckai is:

"Truckai et al. teach the claimed process as evidenced at col 3, lns 40-58; and figs 2A and 4."

The above is the only explanation the Examiner gives for rejecting as anticipated all of the above claims (12 claims in all).

It is respectfully urged that this is not a sufficient basis for the Examiner's rejection. Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The

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identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Here, the Examiner has not applied the teachings of the Truckai reference to explain how Truckai anticipates the claims. It is respectfully urged that the Applicant does not have a full and fair opportunity to respond to the Examiner's rejection, but instead must try to infer what the Examiner was thinking when the Examiner made the rejection. In particular, it is not clear, among other things, what the Examiner considers in Truckai to be the proximal segment and what the Examiner considers in Truckai to be the distal segment

The portion of Truckai cited by the Examiner explains:

FIG 2A shows that a plastic extrusion indicated at 38 can provide the longitudinal inflow lumen 35A and be assembled around, or bonded to, outer sleeve 10A and connected to inflow loop 35B and tip body 36 (See FIG 3).

If the Examiner considers the outer sleeve 10A to be the "proximal needle segment" of Claim 1, and if the Examiner considers the plastic extrusion indicated at 38 as being the "distal needle segment", it is respectfully urged that Truckai still does not anticipate Claim 1 because Claim 1 requires, among other things:

providing a transverse tissue receiving port in the distal needle segment, wherein the transverse tissue receiving port is proximal to the closed tip and distal to the proximal needle segment.

In contrast, Truckai states tissue engaging opening 32 of Truckai is "in a portion of side wall 17 of the outer sleeve 10A" (Truckai at Column 3, lines 7-21). See also Figure 3 which appears to show the opening 32 extending through sidewall 17 of outer sleeve 10A. Accordingly, the opening 32 of Truckai is formed through the outer sleeve 10A, and

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Truckai does not teach providing a transverse tissue receiving port in a distal needle segment where the tissue receiving port is distal to the proximal needle segment.

If the Examiner does not consider the outer sleeve 10A to be the "proximal needle segment" of Claim 1, and/or if the Examiner does not consider the plastic extrusion indicated at 38 as being the "distal needle segment", the Examiner is respectfully requested to point out what specific portions of Truckai the Examiner refers to so that the Applicant has a full and fair opportunity to respond.

Regarding Claims 2 and 3, it is respectfully urged that Truckai does not teach a proximal needle segment providing support in the step of *forming* the distal needle portion, or that the step of forming the distal needle segment comprises molding the distal needle segment about a portion of the proximal needle portion. Instead, Truckai states that :

...plastic extrusion indicated at 38 can provide the longitudinal inflow lumen 35A and be *assembled around, or bonded to, outer sleeve 10A* and connected to inflow loop 35B and tip body 36. (Italics added)

In other words, Truckai's teaching seems to indicate that the extrusion has already been formed (i.e. by a separate extrusion process) when it is assembled around, or bonded to, the sleeve 10A. Truckai does not teach or suggest that the outer sleeve 10A provides support *in the step of forming* plastic extrusion 38, or that the extrusion 38 is provided by molding the distal needle portion about a portion of the sleeve 10A. If the Examiner disagrees, the Examiner is respectfully requested to explain where Truckai specifically teaches the subject matter of Claim 2 and Claim 3.

Regarding Claim 6, the Examiner is requested to specifically identify in what Figure and/or in what text Truckai discloses providing a plurality of passageways extending through an outer surface of the distal needle segment.

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Regarding Claim 9, the Examiner is requested to specifically identify the cutter lumen, the vacuum lumen, and the Figure and text where Truckai discloses forming or otherwise providing a plurality of interlumen holes between a cutter lumen segment and a vacuum lumen segment.

Regarding Claim 10, the Examiner is requested to specifically identify where Truckai discloses a plurality of fluid passages extending from the vacuum lumen segment through an outside surface of the distal needle segment.

Regarding Claim 22, the Examiner is requested to explain how Truckai teaches a liner within a lumen segment defined by one or both of the proximal or distal needle segments.

103 Rejections: Claims 4, 17, 18, 19, 20, 23:

The obviousness rejection of the above listed claims is traversed for at least the following reasons.

First, the rejection of these dependent claims is improper in view of the arguments provided above with respect to Claim 1.

Additionally, regarding Claim 23, the Examiner has not explained where there is a teaching or suggestion to provide a liner, as set forth in Claim 22. It is respectfully urged that the Examiner may not reject Claim 23 based on what the Examiner considers to be an obvious choice of material for a liner when the Examiner has not even provided a basis in the art for holding that providing a liner is anticipated and/or obvious.

One or more of the other dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Applicant reserves all rights and arguments with respect to distinctions not explicitly noted herein. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as

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an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

If the Examiner maintains any rejections, the Examiner is requested to provide a timely Advisory Action in view of this response being mailed within 2 months of the final rejection.

Respectfully submitted,

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